



Docket No.: 358362010400
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masauo MATSUDA et al

Serial No.: 09/889,508

Group Art Unit: 1771

Filed: July 18, 2001

Examiner: Jennifer A. Boyd

For: FLAME-RETARDANT POLYESTER FIBER,
WOVEN OR KNITTED, FLAME-RETARDANT
POLYESTER FIBER FABRIC, NONWOVEN
FLAME-RETARDANT POLYESTER FIBER
FABRIC AND WOVEN OR KNITTED SUEDE
FABRIC

RECEIVED
MAY 29 2003
TC 1700

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed May 7, 2003, applicants elect the claims of Group I, claims 1-7, *with traverse*.

Applicants respectfully traverse the restriction requirement because the Examiner has failed to follow PCT Rule 13.2 and 37 CFR 1.499, as explained at MPEP 1893.03(d). The Examiner's statement of reasoning in support of the restriction requirement demonstrates the inadequacy of the basis for the restriction requirement itself:

The special technical feature of Group 1 is a phosphorus compound copolymerized polyester. The foregoing special technical features shown in the prior art of Endo et al. (US 4,157,436)(Abstract). Therefore, there is no contribution made over the prior art. Hence, there is no unity of invention and lack of unity is held by the Examiner.

The difficulty with this reasoning is that it fails to follow the requirements of the MPEP. MPEP 1893.03(d) requires the Examiner to do two things in making a lack of unity of invention
va-34343

requirement. The Examiner must first "list the different groups of claims," which the Examiner has done here, and then "explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group." The Examiner has not explained why the claims of Group II have special technical features which are unique *as compared with* those of Group I. In fact, the claims of Group II *depend* from claim 1 in Group I, either directly or indirectly, especially since the fabrics of claims 8-11 are specifically claimed as comprising the fiber of claim 1. Thus, both groups of claims *share* the common special technical feature of a flame-retardant polyester fiber comprising a phosphorus compound copolymerized polyester. The Examiner has, therefore, not satisfied the factual burden of demonstrating that the claims of Groups I and II do not share the same special technical feature or features, and the requirement fails for that reason alone.

The Examiner seems to be trying to avoid this difficulty with the reasoning in the Action by holding that the special technical feature of Group I is unpatentable over the prior art. This finding begs the question for two reasons. First, it overlooks the fact that the claims of Groups I and II *share* this technical feature, which shows there is no lack of unity of invention. Second, it is not correct that Endo discloses this alleged feature since there is no evidence that the polyesters disclosed in Endo meet the specific requirements of Formulas 1-3 in claim 1, in particular. It is not enough for the Examiner simply to cite Endo as disclosing the broad parameters of the claimed polyester forming part of the fiber of the invention of the claims of Group I without taking into account all of the limitations of those claims.

Since the Examiner has failed to demonstrate why the identified groups of claims in this application do not share special technical features and has otherwise failed to satisfy the burdens set forth in MPEP 1893.03(d), the restriction requirement should be withdrawn and all of the claims examined together. Applicants respectfully submit the Examiner will, after all, search for the same polyester constituent of both the fiber and the fabric and thus will conduct searches on each group of

claims which are substantially the same, if not identical, in scope.

In the event the Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **358362010400**.

Dated: May 28, 2003

Respectfully submitted,

By 

Barry E. Bretschneider

Registration No.: 28,055

Morrison & Foerster LLP

1650 Tysons Blvd, Suite 300

McLean, Virginia 22102

(703) 760-7743